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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
HUTTON JR, WILLIAM D	
ART UNIT	**PAPER NUMBER**
2176	

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/800,648	SWART ET AL.	
	Examiner	Art Unit	
	Doug Hutton	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,8,10-14,17,20,21 and 23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,8,10-14,17,20,21 and 23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 March 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's Response

In Applicant's Response dated 1/11/06, Applicant submitted a Request for Continued Examination, amended Claims 1, 10, 20, 21 and 23, cancelled Claim 19, and argued against all objections and rejections previously set forth in the Office Action dated 11/7/05.

The objections to the Specification and the claims that were previously set forth are withdrawn. The rejections under 35 U.S.C. 101 for Claims 10-14, 17 and 19 are withdrawn.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/11/06 has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5, 8 and 21 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-5, 8 and 21:

The language of the claims raise a question as to whether the claims are directed merely to an abstract idea that would not result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claim 1 recites "*[a]n apparatus . . . comprising:*" (see Line 1) a "*first logic*" (see Line 2) and a "*second logic*" (see Line 14). Although the preamble identifies the invention as an "*apparatus*," the recited elements of the invention clearly indicate that it is a ***computer program***. Because the claim fails to recite any computer hardware or that the program is embodied on a tangible computer-readable medium, the invention is merely an algorithm and is not useful, concrete or tangible, as currently recited. A computer program, in and of itself, is useless without a computer to run it and/or a tangible computer-readable medium on which to store it. Thus, the invention, as currently recited, is descriptive material per se and non-statutory.

Claim 1 further recites that the "*first logic*" is "***configured to perform*** *a technical writing tool algorithm* ***for***" performing functions (Lines 2-3), including: 1) "*receiving input*" (Line 3); and 2) "*processing said input*" (Line 4). The examiner notes that the "*first logic*" does not actually perform the algorithm; rather, the "*first logic*" is **configured**

to perform the algorithm. Similarly, the algorithm does not actually receive or process input; rather, the algorithm is **for** performing these functions. Stated differently, the claim does not positively recite that the "*first logic*" actually performs the algorithm and that the "*algorithm*" actually performs the recited functions. In other words, the "*first logic*" does nothing and produces no useful, concrete and tangible result.

Claim 1 also recites that the "*first logic*" is "***configured to define*** *styles*" (Line 9) and "***configured to control*** *a style*" (Line 11). The examiner notes that the "*first logic*" does not actually "*define*" or "*control*" anything; rather, the "*first logic*" is **configured to define and control** styles. Again, Claim 1 does not positively recite that the "*first logic*" actually performs these functions.

Finally, Claim 1 recites that the "*second logic*" is "***configured to receive*** *the first markup language file*" (Line 14) and "***configured . . . to perform*** *a conversion algorithm*" (Lines 14-15). The examiner notes that the "*second logic*" does not actually "*receive*" the file or "*perform*" an algorithm; rather, the "*second logic*" is **configured to receive** the file a and **configured to perform** an algorithm. Again, Claim 1 does not positively recite that the "*second logic*" actually performs these functions.

Claims 2-5 and 8 are also rejected because these claims are dependent upon Claim 1 and recite no limitations that make the invention concrete and tangible.

Claim 21 has the same problems mentioned in the above discussion for Claim 1.

Applicant may obviate these rejections by amending the preambles of Claims 1 and 21 to read: — A computer program tangibly embodied on a computer-readable medium, comprising: —.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 8, 10-14, 17, 19-21 and 23 remain rejected under 35 U.S.C. 102(b) as being anticipated by http://web.archive.org/web/19991111161335/http://www.scriptorium.com/index.html (hereinafter, Scriptorium), as it appeared on 1 March 2000.

Claim 1:

Scriptorium discloses *an apparatus for generating files* (see Pages 1-14 of 14 – Scriptorium discloses this limitation, as clearly indicated in the cited text), *the apparatus comprising:*

- *a first logic configured to perform a technical writing tool algorithm* (see Page 2 of 14 – Scriptorium discloses this limitation in that it teaches FrameMaker and

FrameMaker+SGML), *the technical writing tool algorithm for receiving input describing a particular selected format and content for a document* (see Page 2 of 14 – Scriptorium discloses this limitation in that FrameMaker and FrameMaker+SGML allow the user to specify a structure for a document and flow content into the document structure), *the technical writing tool algorithm for processing said input to generate a first markup language file of a first markup language* (see Pages 2-14 of 14 – Scriptorium discloses this limitation in that FrameMaker and FrameMaker+SGML creates SGML documents) *based on an elements file* (see Pages 2-14 of 14 – Scriptorium discloses this limitation in that FrameMaker and FrameMaker+SGML, when creating an SGML document, refer to the document structure specified by the user. The "structure" specified by the user is defined in an Element Definition Document.) *and a plurality of style templates external to said elements file* (see Pages 2-14 of 14 – Scriptorium discloses this limitation in that FrameMaker and FrameMaker+SGML, during the creation of an SGML document, use FrameMaker formatting to style the SGML elements. Scriptorium mentions FrameMaker templates and FrameMaker formatting repeatedly. These templates and formatting comprise "*styles*" for paragraphs, characters, headings, lists, tables, etc. included in the SGML document that is created. In other words, the elements in an Element Definition Document have "*styles*" associated with them through FrameMaker templates and FrameMaker formatting. Because FrameMaker templates and FrameMaker formatting are not part of the Element Definition Document, the "*styles*" are

"*external*" to the "*elements file*." Also, because a user may map FrameMaker tags (which are used to build FrameMaker templates and specify FrameMaker formatting – i.e., FrameMaker "styles") to HTML tags (which are used to build HTML "styles") using WebWorks Publisher, FrameMaker tags - and thus FrameMaker templates and FrameMaker formatting - are "*external*" to the Element Definition Document.), *said elements file defining elements included in said first markup language file and a structure for each of said elements* (Scriptorium discloses this limitation in that the Element Definition Document comprises elements and the structure for each element), *wherein said first markup language file is printable as a hardcopy document* (Scriptorium discloses this limitation in that FrameMaker is used to print SGML hardcopy documents), *said first markup language file including first markup language formatting information* (Scriptorium discloses this limitation in that FrameMaker and FrameMaker+SGML outputs documents in SGML format), *said first logic configured to define styles of said elements in said first markup language file based on said plurality of style templates* (This limitation simply repeats the limitation "*generate a first markup language file . . . based on . . . style templates*" previously recited in Lines 4-5. As indicated in the above discussion, Scriptorium discloses this limitation.), *each of said style templates defining a style for a respective one of said elements* (As indicated in the above discussion, FrameMaker templates and FrameMaker formatting comprise "*styles*" for paragraphs, characters, headings, lists, tables, etc. Thus, each element in an

Element Definition Document has an associated "*style.*"), *said first logic further configured to control a style of one of said elements in said first markup language file and a style of an element in at least one other file of the first markup language based on the same one of said style templates* (see Pages 2-14 of 14 – Scriptorium discloses this limitation in that it teaches that WebWorks Publisher may be used to customize mappings for each FrameMaker file or use the same mappings for multiple FrameMaker files. Thus, through the mappings created in WebWorks Publisher, FrameMaker is "*configured to control*" the style of an element in multiple FrameMaker files. Scriptorium also discloses that WebWorks Publisher may be used to customize WebWorks Publisher styles. Thus, WebWorks Publisher can reuse the mappings for multiple files, and WebWorks Publisher allows the user to customize any of the WebWorks Publisher styles so that the conversion is complete and requires no manual formatting of the converted file.)*; and*

- *a second logic configured to receive the first markup language file and to perform a conversion algorithm that converts the first markup language file into a second markup language file of a second markup language* (see Pages 2-14 of 14 – Scriptorium discloses this limitation in that it teaches WebWorks Publisher, which is a conversion tool that is used to convert FrameMaker files to HTML. That is, WebWorks Publisher may be used to convert SGML documents to HTML documents.) *based on a plurality of mappings for mapping said style templates to styles that are to be used in said second markup language file* (see Pages 2-14

of 14 – Scriptorium discloses this limitation in that it teaches that WebWorks Publisher may be used to map FrameMaker styles to WebWorks Publisher styles by mapping FrameMaker tags to HTML tags. Scriptorium also discloses that WebWorks Publisher may be used to map FrameMaker formats to HTML formats. Finally, Scriptorium discloses that WebWorks Publisher includes FrameMaker element mapping support. The tags, formats and elements define "*styles*" that are mapped.), *wherein said second markup language file includes a second markup language formatting information describing a particular on-line format and content of said document* (see Page 2 of 14 – Scriptorium discloses this limitation in that it teaches HTML documents for publishing online content).

Claim 2:

Scriptorium discloses *the apparatus of Claim 1, wherein said input describing said particular format includes style information that describes a style that document elements are to have if the first markup language file is printed* (Scriptorium discloses this limitation in that FrameMaker allows the user to specify the document structure in the Element Definition Document. The Element Definition Document may be used to output a document in SGML format.).

Claim 3:

Scriptorium discloses *the apparatus of Claim 1, wherein said input describing said particular format includes style information that describes a style that document*

elements are to have if the second markup language file is placed on-line (Scriptorium discloses this limitation in that WebWorks Publisher converts the FrameMaker document into an HTML document that has "style information" that instructs a computer how to present the HTML document online).

Claim 4:

Scriptorium discloses *the apparatus of Claim 1, wherein said first markup language is a Standard Generalized Markup Language* (as specified in the above rejection for Claim 1, the first markup language is SGML).

Claim 5:

Scriptorium discloses *the apparatus of Claim 1, wherein said second markup language is a Hypertext Markup Language* (as specified in the above rejection for Claim 1, the second markup language is HTML).

Claim 8:

Scriptorium discloses *the apparatus of Claim 1, wherein said first markup language is a Standard Generalized Markup Language and wherein said second markup language is a Hypertext Markup Language* (as specified in the above rejection for Claim 1, the first markup language is SGML and the second markup language is HTML).

Claims 10-14 and 17:

Claims 10-14 and 17 merely recite the method performed by the apparatus of Claims 1-5 and 8, respectively. Thus, Scriptorium discloses every limitation of Claims 10-14 and 17, as indicated in the above rejections for Claims 1-5 and 8.

Claim 20:

Claim 20 merely recites computer software that performs the same method performed by the apparatus of Claim 1. Thus, Scriptorium discloses every limitation of Claim 20, as indicated in the above rejection for Claim 1.

Claim 21:

Claim 21 merely recites limitations included in Claim 1. Thus, Scriptorium discloses every limitation of Claim 21, as indicated in the above rejection for Claim 1.

Claim 23:

Claim 23 merely recites the method performed by the apparatus of Claims 1-5 and 8. Thus, Scriptorium discloses every limitation of Claim 23, as indicated in the above rejections for Claims 1-5 and 8.

Response to Arguments

Applicant's arguments filed 1/11/06 have been fully considered but they are not persuasive.

Arguments against the 101 rejections:

Applicant argues that the subject matter recited in Claim 1 is statutory subject matter because the claimed logic may be implemented in software or hardware. See *Response* – Page 11, second paragraph.

The examiner disagrees.

As indicated in the above 101 rejection for Claim 1, the recited elements of the invention clearly indicate that it is a ***computer program*** per se. The claim language fails to recite that the computer program is tangibly-embodied on a tangible computer-readable medium. Thus, the invention recited in Claim 1 is the algorithm itself. The algorithm alone, without the use of a computer, ***cannot*** produce a useful, concrete and tangible result. Accordingly, the subject matter recited in Claim 1 is nonstatutory.

The fact that logic may be implemented in computer software or hardware is not relevant to the question of whether Claim 1 recites statutory subject matter, because the claim ***fails*** to recite that the logic is implemented in computer software or hardware. It is the **claim** that defines Applicant's invention, and the claim does not state that the "logic" is implemented in computer software or hardware. As currently recited, whether the "logic" ***may be implemented*** in computer software or hardware has no bearing on the defined invention in Claim 1.

Applicant argues that the subject matter recited in Claim 1 is statutory subject matter because the logic is "configured to" perform the functions recited in the claim. Thus, Applicant argues, the logic is **required** to be arranged to perform the recited functions (emphasis added). See *Response* – Page 12, first paragraph.

The examiner disagrees.

The examiner agrees that the claim language recites that the "logic" is "configured to" perform various functions. However, logic being "configured to" perform a function does not necessarily mean that the logic is embodied in computer hardware and/or on a computer-readable medium. Instead, the logic may simply define instructions (i.e., an algorithm) that "configures" the logic to perform various functions. In this case, the claim merely recites an algorithm. As indicated in the above 101 rejection for Claim 1, a computer program, in and of itself, is useless without a computer to run it and/or a tangible computer-readable medium on which to store it.

Finally, applicant argues that many issued patents have claims reciting "logic configured to" without reciting that such "logic" is embodied on a computer-readable medium. See *Response* – Page 12, first paragraph.

The examiner will not comment on the claim language recited in issued patents because it is the Office's policy not to comment on the validity of registered patents.

Arguments against the 102 rejections:

Applicant's argues that Scriptorium fails to disclose "*said first logic configured to define styles of said elements in said first markup language file based on said plurality of style templates, each of said style templates defining a style for a respective one of said elements, said first logic further configured to control a style of one of said elements in said first markup language file and a style of an element in at least one other file of the first markup language based on the same one of said style templates*" and "*a second logic configured to receive the first markup language file and to perform a conversion algorithm that converts the first markup language file into a second markup language file of a second markup language based on a plurality of mappings for mapping said style templates to styles that are to be used in said second markup language file*" because the examiner equates FrameMaker tags to the recited "style templates." FrameMaker tags, Applicant argues, are not "templates" that can be reused over and over again to define a style for multiple elements and/or multiple elements in different files. Rather, Applicant argues, FrameMaker tags merely identify a beginning or end of a particular element. See *Response* – Page 13, first paragraph through Page 14, first full paragraph.

The examiner disagrees.

As indicated in the above 102 rejection for Claim 1, Scriptorium discloses that WebWorks Publisher may be used to customize mappings for **each** FrameMaker file or use the **same** mappings for **multiple** FrameMaker files. Also, as indicated in the above 102 rejection for Claim 1, Scriptorium discloses that WebWorks Publisher may be used

to map FrameMaker styles to WebWorks Publisher styles by mapping: 1) FrameMaker tags to HTML tags; 2) FrameMaker formats to HTML formats; and/or 3) FrameMaker element to HTML elements. These tags, formats and elements define the FrameMaker and HTML "*styles*" that are mapped by the user.

Moreover, as demonstrated in http://web.archive.org/web/20000302171547/ http://www.cyberus.ca/~carls/cs_sig97.htm (hereinafter, "Cyberus"), using WebWorks to map FrameMaker styles to HTML styles was well-known in the art at the time the invention was made (see Cyberus – Page 7, fourth paragraph). Thus, although Scriptorium does not expressly recite that FrameMaker styles are mapped to HTML styles, Scriptorium implies that a user may map FrameMaker styles to HTML styles using WebWorks. That is, one of ordinary skill in the art (i.e., a computer programmer working in the area of "unified content" publishing) at the time the invention was made, after having read the entire disclosure of Scriptorium, would have realized that FrameMaker styles may be mapped to HTML styles using WebWorks.

Accordingly, Scriptorium discloses these limitations.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the

application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is 571-272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH
February 2, 2006

DOUG HUTTON
PRIMARY EXAMINER
TECH CENTER 2100